UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,700	05/24/2001	Louis Scott Cole	21132-006	1728

29315   7590   09/08/2005

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

nc

	Application No.	Applicant(s)
Office Action Summary	09/864,700	COLE ET AL.
	Examiner	Art Unit	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 May 2001</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-36</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-36</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some *   c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-36 have been examined.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-20, 22-29, and 31-36 are rejected under 35 U.S.C. 102(e) as being anticipated

by Girn et al., U.S. Patent Application Publication No. 2003/0113727.

3.   As per claim 1, Girn teaches a system for assessing a person's inherited risk for

disease, comprising a server, which is connected to a network, for communicating with a

communication device that is used by the person, the server comprising a risk assessment

program that performs a method comprising the steps of: querying the person for the person's

family history information (see paragraph 0083); receiving family history information inputted by

the person (see paragraphs 0090 and 0091); generating a family tree diagram based on the

received family history information (see paragraph 0099); transmitting the family tree diagram to

the person's communication device (see paragraph 0099); querying the person for family

medical history information concerning members of the person's family (see paragraph 0100);

receiving the family medical history information inputted by the person (see paragraph 0100);

generating a family medical tree diagram based on the received family medical history

information (see paragraph 0101); transmitting the family medical tree diagraph to the person's

communication device (see paragraph 0101); receiving a request to generate a risk assessment

report that assesses the person's inherited risk for one or more diseases based at least in part on the received family medical history information (see paragraph 0109); generating the risk assessment report (see paragraph 0115); and transmitting the risk assessment report to the person's communication device (see paragraph 0116).

4.   As per claim 2, Girn teaches the system of claim 1 as described above. Girn further teaches the step of querying the person for the person's family history information includes the step of transmitting from the server to the communication device one or more web pages that enable the person to enter the person's family history information and transmit the inputted information to the server (see paragraph 0057).

5.   As per claim 3, Girn teaches the system of claim 1 as described above. Girn further teaches storing the received family history information in a database (see paragraph 0079).

6.   As per claim 4, Girn teaches the system of claim 1 as described above. Girn further teaches creating a graphics image file of the family tree diagram (see paragraph 0052).

7.   As per claim 5, Girn teaches the system of claim 1 as described above. Girn further teaches the step of querying the person for family medical history information includes the step of transmitting from the server to the communication device one or more web pages that enable the person to enter family medical history information and transmit the inputted information to the server (see paragraphs 0060, 0061, and 0077).

8.   As per claim 6, Girn teaches the system of claim 5 as described above. Girn further teaches the web page enables the person to indicate that a member of the person's family has been diagnosed with one or more diseases or one or more conditions (see paragraph 0092).

9.   As per claim 7, Girn teaches the system of claim 6 as described above. Girn further teaches the one or more diseases include cancer, diabetes, Alzheimer's, or health disease and the one or more conditions include a pre-cancerous condition (see paragraph 0056).

10.   As per claim 8, Girn teaches the system of claim 7 as described above. Girn further teaches if the person indicates that a member of the person's family has been diagnosed with cancer or a pre-cancerous condition, the step of querying the person for family medical history information concerning members of the person's family further includes the step of asking the person to select the part of the body where the member of the person's family was diagnosed with the cancer or pre-cancerous condition (see paragraph 0089).

11.   As per claim 9, Girn teaches the system of claim 8 as described above. Girn further teaches asking the person to select from a list of cancer types the type of cancer or pre-cancerous condition for which the family member was diagnosed (see paragraph 0089).

12.   As per claim 10, Girn teaches the system of claim 9 as described above. Girn further teaches enabling the person to indicate whether he or she is certain or uncertain of the type of cancer selected (see paragraph 0092, in particular, the "Yes/No/Don't Know" response type).

13.   As per claim 11, Girn teaches the system of claim 6 as described above. Girn further teaches that if a member of the person's family has been diagnosed wit hone or more diseases or one or more conditions, the generated family medical tree diagram highlights the member of the person's family (see column 0102, in particular, "affected individuals" being displayed in a different color).

14.   As per claim 12, Girn teaches a system for assessing a person's inherited risk for a disease, comprising: a communication device having a user interface for allowing the person to receive and input information (see paragraph 0031); a server (see paragraph 0031); a network for allowing the communication device to communicate with the server (see paragraph 0029), wherein the server executes a risk assessment program comprising; a tree-creation module for generating a family medical tree diagram based on family medical history information inputted by the person into the communication device and received by the risk assessment program (see

paragraph 0095); and a risk assessment module for generating a risk assessment report that assesses the person's inherited risk for a disease based on the family medical history information (see paragraph 0115).

15.   As per claim 13, Girn teaches the system of claim 12 as described above. Girn further teaches the network is the Internet (see paragraph 0029).

16.   As per claim 14, Girn teaches the system of claim 13 as described above. Girn further teaches the communication device includes a web browser (see paragraph 0057).

17.   As per claim 15, Girn teaches the system of claim 14 as described above. Girn further teaches the server includes an HTTP server program for communicating with the web browser (see paragraph 0068).

18.   As per claim 16, Girn teaches the system of claim 15 as described above. Girn further teaches the risk assessment program is operable to transmit to the communication device one or more web pages that enable the person to input his or her family history information and to transmit the inputted information to the server (see paragraph 0057).

19.   As per claim 17, Girn teaches the system of claim 16 as described above. Girn further teaches the risk assessment program is operable to transmit to the communication device one or more web pages that enable the person to input his or her family medical history information and to transmit the inputted information to the server (see paragraphs 0060, 0061, and 0077).

20.   As per claim 18, Girn teaches the system of claim 17 as described above. Girn further teaches the server has access to a database for storing the family history information and the family medical history information (see paragraph 0079).

21.   Claims 19-20 and 22-27 recite substantially similar method limitations to those already addressed in claims 1-2, 4, and 6-10 and, as such, are rejected for similar reasons as given above.

22.   Claims 28-29 and 31-36 recites substantially similar means plus function system limitations to those already addressed in claims 1-2, 4, and 6-10 and, as such, are rejected for similar reasons as given above.

Claim Rejections - 35 USC § 103

23.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24.   Claims 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girn et al., U.S. Patent Application Publication No. 2003/0113727 in view of Bleicher et al., U.S. Patent No. 6,820,235.

25.   As per claim 21, Girn teaches the method of claim 20 as described above. Girn does not explicitly teach the family tree diagram is one of a GIF, TIFF, PNG, and JPEG graphics image. Bleicher teaches a system for displaying clinical data in a web-based format in which images may be displayed in GIF or JPEG formats (see column 5, lines 54-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the many available image formats for displaying the family tree diagrams of Girn. One of ordinary skill in the art would have been motivated to employ one of these commonly known types of formats for the purpose of providing a wide choice of available options for displaying the tree diagrams which is identified as a useful tool for identifying patterns of inheritance and risk (See paragraph 0052).

26.   Claim 30 recites substantially similar additional limitations to those already addressed in claim 21 and, as such, is rejected for similar reasons as given above.

Conclusion

27.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- Evans teaches a system for determining individuals risk of hereditary disease.
- Gasper teaches a system for constructing a three-dimensional tree-based data
  display.

28.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner

can normally be reached on Monday-Friday 8am-5:30pm.

29.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

30.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/6/05

C. Luke Gilligan
Patent Examiner
Art Unit 3626